

Remarks

Examiner has shown no reference where the number of subscribers is provided to a mutual fund operator.

Subscribers of a mutual fund are persons indicating they
5 are willing to invest in the fund before the fund is in operation.

Examiner uses Ricketts. Ricketts addresses calculating a number of investors, not subscribers, and addresses using this number for internal calculations,
10 never providing it to a mutual fund operator as claimed. Ricketts investors purchase existing securities, and are therefore not subscribers as claimed.

KSR International v. Teleflex, states, in the slip opinion at 16, "One of the ways in which a patent's subject
15 matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims".

It is noted that the above quotation does not merely
20 say that one need only show that the solution addressed a problem, one must show that the problem was known. Here, Examiner has shown nothing that states a known problem that are covered by the claims, nor any other motivation to

combine these references. Indeed, Examiner hasn't addressed the last element of the independent claims at all, other than to state that a different type of information (number of investors, not subscribers as
5 claimed) was available had someone wanted to provide it. That would not have led someone skilled in the art to make the combination claimed. Examiner appears to be using nothing more than hindsight in an attempt to piece together the elements of the claims. KSR at 17 warns that hindsight
10 reasoning is still not permitted.

Furthermore, the independent claims recite that the total number of subscribers of a mutual fund is provided to mutual fund management responsive to the close of the subscription period. This claimed feature is ignored
15 entirely by the references. However, because the new claims are dependent on the existing unamended independent claims, which are patentably distinguishable for the reasons set forth above, no new search is required.

Thus, the independent claims are patentably
20 distinguishable over the cited references.

New claims 17 and 18 recite the features of the independent claims and are distinguishable on that basis. These claims are further distinguishable on the basis that

none of the references discloses providing a number of
subscribers to an operator of a mutual fund using
information collected by a broker before the mutual fund
was in operation. Support for these amendments is
5 included, without limitation, at pages 9-10 of the
disclosure.

Respectfully submitted,

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